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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,350	03/16/2004	Mark S. Nichols	7522-8	2106
30448	7590	08/10/2005	EXAMINER.	
AKERMAN SENTERFITT			ROWAN, KURT C	
P.O. BOX 3188			ART UNIT	
WEST PALM BEACH, FL 33402-3188			PAPER NUMBER	

3643

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/801,350

Applicant(s)

NICHOLS, MARK S.

Examiner

Kurt Rowan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 31-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the shank receiving cavity.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7, 10,11, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtle, Jr. in view of McClellan.

The patents to Hurtle and McClellan show fishing lures. Hurtle shows a body 14,15 having at least one cavity 18 in a midsection of the body and at least one opening 32 in a top surface of the body. Hurtle shows a hook 20 having a weight 24 coupled to the hook along a shank 28 of the hook such that the hook is positioned closer to the line receiving portion 22 of the hook wherein the hook is positioned in the at least one cavity such that at least a portion of the weight contacts inner surfaces of the cavity thereby resisting the hook from being pulled from the body when the hook is pulled. Hurtle shows a shank receiving cavity (not labeled) where the shank passes through the front of the body as shown in Fig. 1. The shank receiving cavity extends from the cavity

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containing the weight 24 and the nose of the body at eye hole 23. The patent to McClellan shows a fishing lure having a weight 35 mounted on a fishing hook closer to the throat of the hook than the line receiving portion 28 of the hook. In reference to claim 1, it would have been obvious to provide Hurtle with a weight mounted hook as shown by McClellan to change the action of the lure in the water. In reference to claim 15, Hurtle shows an eye 22 protruding from or through a leading surface of the body. In reference to claim 16, the combination of Hurtle as modified by McClellan does not show the midpoint of the weight positioned at a mid-section of the body, but it would have been obvious to position the midpoint of the weight at a mid-section of the body since the change in location of parts is obvious. See *In re Japikse*, 86 USPQ 70.

3. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtle, Jr. in view of McClellan as applied to claim 1 above, and further in view of Pippert.

The patents to Hurtle and McClellan show fishing lures and have been discussed above, but do not show a body saving device coupled to the base. The patent to Pippert shows a fishing lure having a body saving device 16 coupled to the base 14. In reference to claim 6, it would have been obvious to provide the fishing lure of Hurtle as modified by McClellan with a body saving device as shown by Pippert to retain the soft plastic fishing lure to the body. Pippert shows one protrusion 16, but it would have been obvious to have more than one for multiplied effect. See *In re Harza* 124 USPQ 378.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtle in view of McClellan as applied to claim 1 above, and further in view of Huppert.

The patents to Hurtle, Jr. and McClellan show fishing lures as discussed above, but do not show a plurality of ribs extending around the body. The patent to Huppert shows a fishing lure having a plurality of ribs 61 extending around the body in Fig. 5. In reference to claim 13, it would have been obvious to provide the lure of Hurtle as modified by McClellan with a plurality of ribs as shown by Huppert to resemble a target species.

5. Claims 12, 17-22, 27, 28, 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtle, Jr. in view of McClellan as applied to claim 1 above, and further in view of Admitted Prior Art.

The patents to Hurtle and McClellan show fishing lures and have been discussed above. The combination shows a head and a tail, but not a plurality of legs extending from the head which is shown in Figs. 1-2 as "Prior Art". In reference to claims 12, 17, it would have been obvious to provide the lure of Hurtle as modified by McClellan with a plurality of legs as shown by the Admitted Prior Art of Figs. 1-2 for the purpose of making the lure resemble a shrimp which is a desired prey species. In reference to claim 27, McClellan discloses a lead weight.

6. Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtle, Jr. as modified by McClellan and Admitted Prior Art as applied to claim 17 above, and further in view of Pippert.

The patents to Hurtle, Pippert, and McClellan show fishing lures and have been discussed above. The Admitted Prior Art has also been discussed above. In reference to claim 23, it would have been obvious to provide the lure of Hurtle as modified by McClellan and Admitted Prior Art with a body saving device as shown by Pippert to retain the soft plastic lure on the body as disclosed by Pippert in column 4, line 21.

### ***Response to Arguments***

7. Applicant's arguments filed May 23, 2005 have been fully considered but they are not persuasive. Applicant's response overcomes the objection to claim 20 and the rejection of claims 1-30 under 35 USC 112, second paragraph. In response to applicant's argument that the action of the lure is much different than the prior art, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the protrusions recited in claim 6 while the reference to Pippert shows a barb protrusion) are not recited in the rejected claim in such a way to overcome the art of record. Although the claims are interpreted in light of the specification, limitations from the specification are not read into

the claims. The claim should be further limited to overcome this ground of rejection.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is (571) 272-6893. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a stylized flourish at the end.

Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR